

REMARKS

In accordance with the foregoing, claim 6 is amended for form. New claims 7-14 are presented. No new matter is presented in any of the foregoing and, accordingly, approval and entry of the amended and new claims are respectfully requested.

Claims 1-14 are pending and under consideration.

PAGE 2: REJECTION OF CLAIM 6 UNDER 35 U.S.C. §101

The Examiner rejects claim 6 contending claim 6 is directed to non-statutory subject matter. Claim 6 is amended herein for form to indicate that the claim is directed to "a computer-readable medium storing a program that causes a computer as an information apparatus to manage transaction slip data used in electronic commerce by . . . "

Applicants submit that claim 6, as amended, complies with 35 U.S.C. §101 and request withdrawal of the rejection.

PAGES 2-5: REJECTION OF CLAIMS 1-4, 6 UNDER 35 U.S.C. §103(a) OVER HALUSKA (U.S.P. 5,638,519 IN VIEW OF MCELHINEY (U.S.P. 5,71,915)

According to aspects of the present invention, management data can be composed by a user in a form desired by merely changing a structure of information of a management data document that extracts a part for the management data. For example, a target of a search can be changed dynamically by changing an item extraction instruction. Further, according to aspects of the present invention, both management data and transaction slip data can be constituted from XML form documents and stored, in their entirety, in a database for handling in the form of XML documents.

Prima Facie* Obviousness Not Established*Features Not Described By Cited Art Alone Or In Combination**

As provided in MPEP §2143.03 "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F. 2d 1981, (CCPA 1974)."

Independent claim 1 recites a managing apparatus including "a data extracting unit extracting data as a search item of the transaction slip data document therefrom; a storing unit storing the data extracted by said data extracting means as management data in correlation with the transaction slip data; (and) a transaction slip data extracting unit searching the management data so as to extract correlated transaction slip data." (Emphasis added).

Independent claim 6, as amended, recites a computer-readable medium storing a program that causes a computer as an information apparatus to manage transaction slip data

used in electronic commerce by "extracting data as a search item of a transaction slip data document therefrom; storing the data extracted . . . as management data in correlation with the transaction slip data. . . (and). . . searching the management data so as to extract correlated transaction slip data." (Emphasis added).

Dependent claim 2 recites a managing apparatus "wherein the correlation between the management data and the transaction slip data is managed with a document identifier that is common therebetween." (Emphasis added). Dependent claim 3 recites a managing apparatus including "a receiving unit receiving the transmitted transaction slip data; and a converting unit converting the format of the received transaction slip data into a format with which a transmission destination can deal. " (Emphasis added). Dependent claim 4 recites "designation of a search item as the management data is dynamically changeable." (Emphasis added).

The Action concedes that Haluska does not teach:

. . . that "management data" is extracted from the "transaction slip data" and that the "management data" is stored and searched in correlation with the transaction slip data.

(Action at page 3).

The Action also concedes that McElhiney does not teach:

data decomposed by the system is transaction slip data or that the system is implemented specifically for e-commerce.

(Action at page 4).

Nevertheless, the Examiner rejects claims 1-4 and 6 and contends that McElhiney:

. . . is designed to manage any type of data, which involves a large amount of data records . . . data stored is non-functionally descriptive in nature and the data managed and stored by the system of McElhiney could have been of type, transaction slip/sales or otherwise.

(Action at page 4).

Examiner's Contentions Unsupported

Applicants respectively submit that the Examiner's contentions, for example, contending data is "non-functionally descriptive" are unsupported takings of official notice. As understood in the art, different types of data can require different handling, managing, and storing.

As set forth in MPEP §2144.03 Taking of Official Notice Is Unsupported:

It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts . . . must always be supported by citation to some reference work recognized as standard in the pertinent art. In re Ahlert, 424 F.2d at 1091, 165 USPQ at 420-21.

Applicants request the Examiner support the taking of official notice with appropriate references

or withdraw the rejection.

No Reasonable Expectation of Success Stated Within the Cited Art To Combine In The Manner Proposed By The Examiner

According to aspects of the present invention, users may use respectively different search items without changing transaction slip data, even if such users search for the same data, by merely changing a structure information of a management data document e.g., the structure information regards management data extraction. (See, for example, FIGs. 8-15). This is because a content of the management data can be easily changed according to a structure information of a management data document, and both management data and transaction slip data are stored in a database in their original XML document forms instead of the data sets respectively corresponding to items of each XML document being stored under corresponding items a database table.

Aspects of the invention including management data transaction slip data as constituted from XML form documents, stored in a database in the XML form documents and handles as XML form documents is clearly different from feature associated with McElhiney in which management data searched through is stored in a database in a structure form. Even assuming *arguendo* that if Haluska and McElhiney were combined, such a combination does not teach aspects of the present invention i.e., it would be necessary to restructure a search table that represents a part corresponding to the management data.

Conclusion

Since features of the claims are not taught, there is no success of an *arguendo* combination, official notice is not supported and *prima facie* obviousness is not established, the rejection should be withdrawn and claims 1-4 and 6 allowed.

PAGES 5-6: REJECTION OF CLAIM 5 UNDER 35 U.S.C. §103(a) OVER HALUSKA (U.S.P. 5,638,519 IN VIEW OF MCELHINEY (U.S.P. 5,71,915)

Dependent claim 5 recites that "the transaction slip data document is an XML document, and wherein a search item is dynamically changed by changing the designation of an extraction of an item corresponding to a tag of the XML document."

***Prima Facie* Obviousness Not Established**

As provided in MPEP §2143.03 "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F. 2d 1981, (CCPA 1974)." The Action concedes that the combination of Haluska and McElhiney does not teach:

the transaction slip data document is an XML document and the search item is dynamically changed by changing the designation of an extraction of an item."

(Action at page 5).

Nevertheless the Examiner rejects claim 5 and contends that:

. . . XML documents (are) merely (a) format of presenting data . . . Just as the type of data stored on the database is non-functionally descriptive, so is the format of the data, it therefore would have been obvious for the system of Haluska/McElhiney to be able to store *any* type or format of data.

(Action at page 4).

Taking Of Official Notice Unsupported

Applicants submit that the Examiner's contention of the type of data as non-functionally descriptive is an unsupported taking of official notice. Applicants request the notice be supported or the rejection be withdrawn.

Examiner's Contention of Inherency Unsupported

The Examiner also contends that McElhiney teaches to "extract the correlated data record; inherently comprising that the designation of a search item is dynamically changeable- the administrator sets the constraints for the system." However, the Examiner has not provided any support for such an inherency argument.

As set forth in MPEP 2112:

To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)

That is, the Examiner does not provide any support, whatsoever in rejecting the claim 5 feature of a search item is dynamically changed by changing the designation of an extraction of an item corresponding to a tag of the XML document.

Conclusion

Since *prima facie* obviousness is not established, and the Examiner's contentions of official notice and inherency are unsupported, the rejection should be withdrawn and claim 5 allowed.

NEW CLAIMS

New claims 7-10 recite a method of managing transaction slip data used in electronic commerce "extracting data as a search item of a transaction slip data document therefrom." New claims 11-14 recite a computer-readable medium storing a program to perform managing transaction slip data used in electronic commerce, by "extracting data as a search item of a transaction slip data document therefrom."

These, and other, features of claims 7-14 patentably distinguish over the cited art, and they are submitted to be allowable for the recitations therein.

CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: July 26, 2004

By: Paul W. Bobowiec
Paul W. Bobowiec
Registration No. 47,431

1201 New York Avenue, NW, Suite 700
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501